

PATENT
P56011



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of:

Appeal No. _____

CHUN-GEUN CHOI *et al.*

Serial No.: 09/531,005

Examiner: JOSEPH, THOMAS J.

Filed: 20 March 2000

Art Unit: 2174

For: VIDEO DISPLAY APPARATUS HAVING HOTKEY FUNCTIONS AND A
METHOD THEREFOR

Attn: Board of Patent Appeals & Interferences

REPLY BRIEF

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Sir:

Pursuant to 37 C.F.R. §1.193(a) and (b), Appellant hereby requests entry of this Reply Brief in response to the Examiner's Answer mailed on 3 November 2003 (Paper No. 16).

This Reply Brief is filed in triplicate (37 C.F.R. §1.192(a)), together with a written Request for An Oral Hearing before the Board of Patent Appeals and Interferences, and the statutory fee incurred by that request.

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Date: 12/29/03
I.D.: REB/JGS/kf

REMARKS

The Examiner's Answer mailed on 3 November 2003 (Paper No. 16) has been carefully considered. It is noted that the Examiner's Answer contains several new arguments not previously presented. Appellants respond to these new arguments below.

On page 4 of the Answer, the Examiner again admits that Kurtenbach *et al.*, U.S. Patent No. 6,414,700 fails to teach an OSD unit for outputting an OSD character display signal to a video processing unit in response to a key signal such that actuation by a user of a hotkey button causes a screen display of one or more OSD characters. However, the Examiner then alleges that Kurtenbach *et al.* '700 "does suggest the need for specific personalize [*sic*] hotkeys by proposing a GUI containing numerous operations that are accessible with a minium number of cursor selections" (emphasis supplied -- page 4, lines 5-7 of the Answer). The Examiner cites column 1, lines 35-55 of Kurtenbach *et al.* '700 in support of the latter statement, and adds a new argument to the effect that "[t]his need also suggest [*sic*] the need for key actuations" (quoting from page 4, line 8 of the Answer).

Appellants respectfully disagree. In short, the suggestion in Kurtenbach *et al.* '700 that "numerous operations" can be accessed "with a minimum number of cursor selections" does not at all suggest the use of hotkeys, as alleged by the Examiner. In fact, in the text cited by the Examiner, Kurtenbach *et al.* '700 cites the disadvantages of using hotkeys -- "hard to physically articulate", "hard to remember", "hard to represent the structure of menus" (*see* column 1, lines

53-57 of Kurtenbach *et al.* '700). Thus, contrary to the Examiner's allegation that Kurtenbach *et al.* '700 suggests the use of hotkeys, actually, Kurtenbach *et al.* '700 teaches away from the use of hotkeys. As a result, one of ordinary skill in the art, upon reviewing Kurtenbach *et al.* '700, would not be led to the use of hotkeys or key actuations, as in the claimed invention, and would not be led to the disclosure of customized hotkeys in Foster '870.

On page 8 of the Answer, the Examiner alleges that customization of “keys on a keyboard or GUI enables the user to customize an application according to personalized needs,” and that “[t]his is a capability that is included with numerous software packages” (quoting from page 8, last two lines of the Answer). However, the Examiner cites no evidence in support of the latter statement, and thus relies on his own opinion. This is not a proper basis for a rejection under 35 U.S.C. §103, as indicated by the various legal opinions cited on pages 15-19 of the Substitute Appeal Brief filed on 10 October 2003.

Finally, it should be emphasized that, even if the cited references are properly combinable under 35 U.S.C. §103 (and Appellants do not concede that they are), the combination does not disclose or suggest each element and function of independent apparatus or system claims 1 and 8, and each element and/or step of independent method claims 5 and 7. For example, where in the references is there a disclosure of the button unit, memory unit, OSD unit and control unit recited in claim 1, or the TV display, memory unit, selecting means, generating means, control means, receiving means, reading (or fetching and reading) means and sending means recited in claim 8?

Furthermore, where in references cited is there a disclosure of the three steps recited in method claim 5 or the three steps recited in method claim 7? The previous Office actions, the present final Office action, and the subsequent Advisory Action do not provide an indication as to where the above elements or steps are disclosed. Whereas the Examiner does provide some general references to certain figures or certain portions of the text of the two cited patents, there is no stated correlation between the elements and steps/functions recited in the claims and specific elements or textual passages in the cited patents.

In the continuation sheet for paragraph 5 of the Advisory Action of 20 June 2003 (Paper No. 10), the Examiner merely states that “Kurtencech[*sic*] teaches a TV display, memory unit, selecting means, generating means, control means, receiving means, reading means, and sending means (fig. 2; fig. 6, #114, #110, #112)”(quoting from the continuation sheet of the Advisory Action). However, although this statement is slightly more specific than statements raised in the two previous Office actions, there is still no statement on the record as to what specific elements in the cited reference correspond to each of the eight elements of the invention as listed in the Examiner’s statement (quoted above). In fact, in the above-quoted statement, the Examiner identifies eight claimed elements as being allegedly disclosed in Kurtenbach *et al.* ‘700, but the statement only contains three listed reference or numbers (110, 112 and 114). Thus, not all of the claimed elements are accounted for in the Examiner's statement.

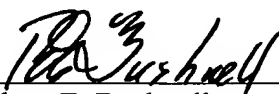
Conclusion

For the reasons stated above, the requirements for a proper and valid rejection under 35 U.S.C. §103 have not been satisfied in the final Office action, and thus the claimed invention is clearly distinguishable over the cited prior art so as to preclude such a rejection.

In view of the law and facts stated herein, as well as all of the foregoing reasons, Appellants believe that the rejection is improper, and respectfully request that the Board refuse to sustain the outstanding rejection of claims 1 thru 10 under 35 U.S.C. §103.

A Request for Oral Hearing and an Appellants' check in the amount of \$290.00 drawn to the order of Commissioner accompany this Reply Brief. Should the Request and/or check become lost, the Commissioner is kindly requested to treat this paragraph as such a request, and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fee.

Respectfully submitted,



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